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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/285,700	04/05/1999	YASUO NISHIDA	P17762	4029
7055	7590	01/10/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/285,700

Applicant(s)

NISHIDA ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 53,54,56-61 and 63-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53,54,57-61,64-66 and 70 is/are rejected.
- 7) ☒ Claim(s) 56,63,67-69 and 71-75 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 6/30/04, and has been entered and made of record. Currently, **claims 53, 54, 56-61, and 63-75** are pending.

### ***Response to Arguments***

2. Applicant's arguments, see pages 9-11, filed 6/30/04, with respect to the rejection(s) of claim(s) 53, 59, 60, 61, and 66 under 35 U.S.C.102(e), as being anticipated by Maeda (U.S. Patent Number 6,690,480) have been fully considered and are persuasive, as the effective filing date of the present application is April 6, 1998 as a result of the submitted translated copy of the foreign priority document. Therefore, the rejection has been withdrawn. However, upon further consideration and review of the cited references, a new ground(s) of rejection is made in view of the previously cited reference of Fite, Jr. *et al.* (U.S. Patent Number 5,517,324).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 53, 54, 57-61, 64-66, and 70** are rejected under 35 U.S.C. 102(b) as being anticipated by Fite, Jr. *et al.* (U.S. Patent Number 5,517,324, cited in the Office action dated 3/28/03).

Regarding **claim 53**, Fite, Jr. discloses a communication apparatus (see Fig. 1) comprising a facsimile communicator that performs a facsimile communication with a facsimile destination via a telephone network (column 4, lines 1 through 66), a communicator that performs electronic mail communication with a destination terminal via a computer network (column 4, lines 1 through 66), a detector that detects identification information included in a non-standard signal which is transmitted from the facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 11, lines 45-67), the identification information indicating that a facsimile destination is capable of electronic mail communication (column 4, lines 1 through 66, and column 11, lines 3-67), and a facsimile communication controller that disconnects the facsimile communication when the detector detects the identification information in the non-standard signal (column 11, lines 56-67, whereby if a particular e-mail protocol is not supported, the call is terminated).

Regarding **claim 54**, Fite, Jr. discloses the apparatus discussed above in claim 53, and further teaches of a memory that is configured to store the identification associated with the facsimile destination (column 4, lines 26-66, and column 11, line 11-column 12, line 31).

Regarding **claim 57**, Fite, Jr. disclose the apparatus discussed above in claim 53, and further teaches that the non-standard signal includes capability information of the facsimile destination (column 11, lines 56 through 67, and column 7, line 21 through column 8, line 34).

Regarding **claim 58**, Fite, Jr. disclose the apparatus discussed above in claim 57, and further teaches that the capability information includes at least resolution (column 3, lines 2 through 12, column 5, lines 3 through 24, and column 7, lines 1 through 20), print paper size (column 3, lines 2 through 12, column 5, lines 3 through 24, and column 7, lines 1 through 20), and coding system (column 5, line 3 through column 6, line 11, and column 7, lines 1 through 20).

Regarding **claim 59**, Fite, Jr. discloses a communication apparatus (see Fig. 1) comprising a facsimile communicator that performs a facsimile communication with a facsimile destination via a telephone network (column 4, lines 1 through 66), a communicator that performs electronic mail communication with a destination terminal via a computer network (column 4, lines 1 through 66), an obtainer that obtains an electronic mail address of the facsimile destination, included in a non-standard signal which is transmitted from the facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 11, lines 45-67), when the facsimile destination with which the facsimile communication section performs the facsimile communication, is capable of electronic mail communication (column 4, lines 1 through 66, and column 11, lines 3-67), and a facsimile

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communication controller that disconnects the facsimile communication when the obtainer obtains the electronic mail address of the facsimile destination (column 11, lines 56-67, whereby if a particular e-mail protocol is not supported, the call is terminated).

Regarding **claim 60**, Fite, Jr. discloses a communication apparatus (see Fig. 1) comprising a facsimile communicator that performs a facsimile communication with a facsimile sender via a telephone network (column 4, lines 1 through 66), an electronic mail communicator that performs electronic mail communication with a communication terminal via a computer network (column 4, lines 1 through 66), and an adder that adds identification information to a non-standard signal which the facsimile communicator transmits to the facsimile sender during a facsimile protocol communication (column 11, lines 45-67), the identification information indicating that a communication apparatus is capable of electronic mail communication (column 4, lines 1 through 66), detection of the identification information disconnecting a facsimile communication (column 11, lines 56-67).

Regarding **claim 61**, Fite, Jr. discloses a method for identifying a destination terminal, the method comprising performing a facsimile communication with a destination terminal via a telephone network (column 4, lines 1 through 66), detecting whether identification information is included in a non-standard signal which is transmitted from the destination terminal while a facsimile protocol transmission is performed with the destination terminal (column 11, lines 45-67), the identification information indicating that a facsimile destination is capable of electronic mail communication (column 4, lines 1 through 66, and column 11, lines 3-67), storing the identification information when the identification information is detected (column 4, lines 26-66, and column 11, line 11-column 12, line 31), and disconnecting the facsimile communication

when the detecting detects the identification information in the non-standard signal (column 11, lines 56-67, whereby if a particular e-mail protocol is not supported, the call is terminated).

Regarding **claim 64**, Fite, Jr. discloses the method discussed above in claim 61, and further teaches that the non-standard signal includes capability information of the facsimile destination (column 11, lines 56 through 67, and column 7, line 21 through column 8, line 34).

Regarding **claim 65**, Fite, Jr. discloses the method discussed above in claim 64, and further teaches that the capability information includes at least resolution (column 3, lines 2 through 12, column 5, lines 3 through 24, and column 7, lines 1 through 20), print paper size (column 3, lines 2 through 12, column 5, lines 3 through 24, and column 7, lines 1 through 20), and coding system (column 5, line 3 through column 6, line 11, and column 7, lines 1 through 20).

Regarding **claim 66**, Fite, Jr. discloses a method for transmitting an electronic mail communication function capability from a receiving terminal to a facsimile sender (see Fig. 1), the receiving terminal having an electronic mail communication section that performs electronic mail communication with a communication terminal via a computer network (column 4, lines 1 through 66), the method comprising performing a facsimile communication with the facsimile sender via a telephone network (column 4, lines 1 through 66), and adding identification information to a non-standard signal included in a facsimile protocol transmission while the facsimile protocol is performed with the facsimile sender (column 11, lines 45-67), the identification information indicating that the communication apparatus is capable of electronic mail communication (column 4, lines 1 through 66), detection of the identification information disconnecting a facsimile communication (column 11, lines 56-67).

Regarding **claim 70**, Fite, Jr. discloses the method discussed above in claim 61, and further teaches that when the detecting does not detect the identification information, transmission via a facsimile communication with the destination is performed (column 4, line 50-column 5, line 24, and column 11, lines 3-55).

#### ***Allowable Subject Matter***

5. **Claims 56, 63, 67-69, and 71-75** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claims 56, 63, 67-69, and 71-75**, in the examiner's opinion, it would not have been obvious to have the apparatus and methods, as claimed, begin performing the electronic mail communication upon disconnection of the facsimile communication.

#### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa  
Examiner  
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jrp